REMARKS

Claims 1-23 are pending in the present application, and claims 1-23 have been rejected. Reconsideration of the claims is respectfully requested.

Applicants thank the Examiner for the interview conducted on September 30, 2004. During the interview, the following points were discussed:

1. 35 U.S.C. § 103, Obviousness

The Office Action has rejected claims 1-2, 4, 10-13, 15, and 21-23 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,438,583 to McDowell et al. (hereinafter McDowell) in view of U.S. Patent No. 6,185,603 to Henderson (hereinafter Henderson). This rejection is respectfully traversed.

With respect to the rejection of claim 1, the Office Action states the following:

> ...McDowell discloses the re-route server, after receiving e-mail; determines if the recipient of the e-mail is a re-route customer, wherein if the recipient is determined to be a re-route customer then it is determined that the e-mail for the recipient is to be forwarded to the recipient's "toAccount" address or another address provided by the recipient);
>
> while McDowell discloses a system for re-routing or forwarding e-mail from a prior or non-working address to a new address of a recipient, McDowell does not particularly disclose including an indicator identifying the message as forwarded from an old address if the electronic message is to be forwarded to another address associated with the recipient. Nonetheless, including an indicator that identifies a message as forwarded and from were it was forwarded is well known in the art as evidenced by Henderson.
>
> In similar art Henderson discloses a system for the delivery of e-mail and alerting messages wherein typical email messages include normal headers and a message portion that indicates the source of the message and from where it was forwarded (col. 5, lines 52-55).
>
> Given the teachings of Henderson a person having ordinary skill in the art would have readily recognized the uses and advantages of modifying the system for re-routing e-mail messages, as disclosed by McDowell, by including the well known indicator that identifies the message as being forwarded from an old address, such as disclosed by Henderson, in order to distinguish the forwarded e-mail from the regularly received e-mail and also to inform the user that the e-mail was send from a known and secure source.

Office Action dated 7/8/2004, pages 2-3.

Applicants respectfully disagree. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of

ordinary skill in the art, to modify the reference or to combine reference teachings.
Second, there must be a reasonable expectation of success. Finally, the prior art reference
(or references when combined) must teach or suggest all the claim limitations.

McDowell describes a mechanism for re-routing of e-mail sent to a prior address
of a recipient to a new address of the recipient. E-mail is sent to a former ISP of the
intended recipient and is then re-routed to a re-route server that causes the e-mail to be
sent to the correct address. For example, Figure 1A of McDowell shows the following:

Figure 1A
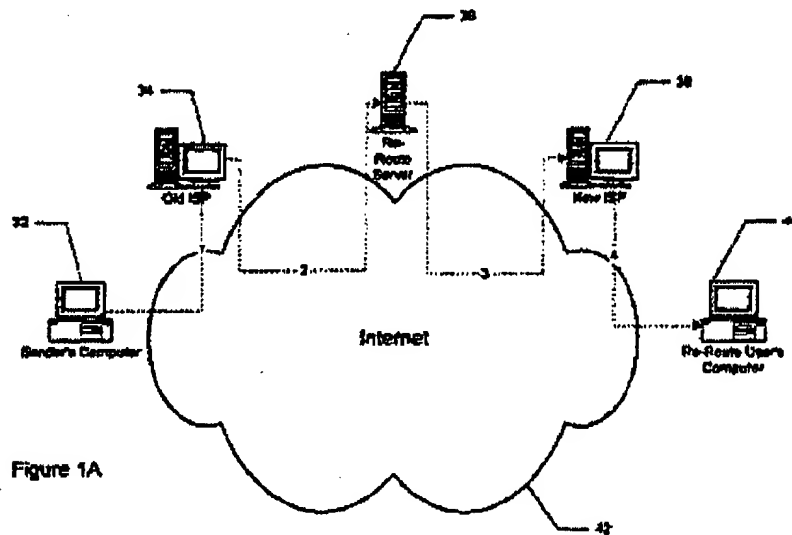
As can be seen, an email is sent form a sender's computer to an old ISP of a user. The
old ISP sends the email to a re-route server that then sends the e-mail to the user's new
ISP. The email is then transmitted to the user. As noted by the Examiner, McDowell fails
to describe including an indicator identifying the message as forwarded from an old
address if the electronic message is to be forwarded to another address associated with
the recipient.

However, McDowell actually teaches away from including an indicator
identifying the message as forwarded from an old address if the electronic mail message
is to be forwarded to another address associated with the recipient. For example,
McDowell recites the following:

...a sending computer 32 sends an e-mail addressed to the old ISP 34. The old ISP 34, knowing that the recipient has moved, forwards the message to the re-route server 36. The re-route server 36 has had its toAccount and IP address for the recipient updated. The *e-mail address is changed* by the re-route server 36 and directed to the new ISP 38 for deliver over the Internet 42 to the recipient 40. *(emphasis added)*.
Column 10, Lines 39-45

...re-route server 36 provides the updated X.500 database to the old ISP 34. Thereafter, a sender's computer 32 sends an e-mail to a recipient at the old ISP 34. Old ISP 34 matches the incoming e-mail with the X.500 database and new address for the recipient. Thereafter, *the e-mail is re-addressed* and sent to the new ISP 38 over the Internet 42 for subsequent delivery to the recipient 40. *(emphasis added)*.
Column 11, Lines 4-11

Thus, the old email address is *changed* by the re-route server or otherwise *re-addressed* to facilitate re-routing of the email message to the other address associated with the recipient. Thus, the recipient has no indication that the email message was originally addressed to the old email address.

Henderson describes a mechanism for controlling the appearance of a message when it gets delivered. A sender is able to include an escape sequence that is recognized by a server for controlling the features of the alerting message. Additionally, Henderson describes a typical email message header that may include a message source and from where it was forwarded if any forwarding was performed. For example, Figure 3 of Henderson shows the following:

FIG. 3

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From sandi@research.att.com Wed Oct 23 22:09:12 1996
Received: from sentalin.research.att.com (sentalin.research.att.com [135.16.210.14]) by
learm.research.att.com (8.7.5/8.7.3) with ESMTP id WAA06015 for <don@learm.research.att.com>;
Wed. 23 Oct 1996 22:09:11 -0400 (EDT)
Received: from chara.research.att.com (chara.research.att.com [135.16.210.133])
by sentalin.research.att.com (8.7.5/8.7.3) with ESMTP id VAA06052 for<don@research.att.com>; Wed,
23 Oct 1996 22:09:15 -0400 (EDT)
From: Sandi van Pier <sandi@research.att.com>
Received: (from sandi@localhost) by chara.research.att.com (8.7.5/8.7.3) id VAA14158 for
don; Wed,23 Oct 1996 22:12:27 -0400 (EDT)
Date: Wed. 23 Oct 1996 22:12:27 -0400 (EDT)
Message-Id: <199610240202.VAA14158chara.research.att.com>
To: don@research.att.com
Subject: |(Timed-10/455-1:00pm)(10/455-2:30pm  Meeting at 2pm Thursday in Rm-4p323)
Status: R


A reminder:
The Research meeting is 2pm, Thursday 10/24 in room 4p323...


                    Sandi
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As can be seen, Henderson shows only To and From fields that respectively indicate originator and recipient email addresses. In the case that an email address is forwarded from one user to another, the forwarded email address will indicate the email address of the user that forwarded the email address, as is known. Henderson in no manner shows or suggests a mechanism for "including an indicator identifying the electronic mail message as being forwarded from the old address" of a recipient if the electronic mail message "is to be forwarded to the another address associated with the recipient", nor for "sending the electronic mail message with the indicator" to another address associated with a recipient when the electronic mail message is forwarded from an old address associated with the recipient. Rather, Henderson only indicates that a message may be forwarded from a sender to a recipient and that a header may include an indication of a sender that forwarded the message to the recipient.

Thus, Henderson is insufficient to teach or suggest the deficiencies of McDowell. Accordingly, the teachings of the references are not sufficient to render the claims *prima*

facie obvious. For the foregoing reasons, Applicants submit that claim 1 is patentable over McDowell in view of Henderson, and such a notice is respectfully requested.

Independent claims 10, 11, 12, 21, 22, and 23 recite similar features as claim 1. Therefore, the same distinctions between McDowell and Henderson and the claimed invention in claim 1 apply for these claims. For the reasons described above, McDowell and Henderson do not contain all elements of independent claims 1, 10, 11, 12, 21, 22, and 23. Hence, McDowell and Henderson fails to obviate the present invention as recited in claims 1, 10, 11, 12, 21, 22, and 23. Since claims 2 and 4 depend from claim 1, and claims 13 and 15 depend from claim 12, the same distinctions between McDowell and Henderson and the claimed invention in independent claims 1 and 12 apply for these claims. Additionally, claims 2, 4, 13, and 15 claim other additional combinations of features not suggested by McDowell and Henderson. Consequently, it is respectfully urged that the rejection of claims 1, 2, 4, 10-13, 15, and 21-23 under 35 U.S.C. § 103(a) over McDowell in view of Henderson has been overcome, and such a notice is respectfully requested.

It appears that claims 10, 21, and 23 were additionally rejected under 35 U.S.C. § 103(a) over McDowell in view of U.S. Patent 5,703,783 to Allen et al. (hereinafter Allen) although no formal rejection is set forth in the Office Action. Nevertheless, Applicants note that Allen generally describes a system for intercepting and forwarding incorrectly addressed postal mail. With regard to Allen, the Office Action states:

> Allen, whose system is an apparatus for intercepting and forwarding postal mail discloses wherein when mail is identified as in need of forwarding, the forwarding address and delivery point ZIP marking number are printed on the mail piece *in place of the incorrect address* and the mail piece is returned to the mail stream for delivery to the addressee (see abstract).
>
> Although the environments are different one being semi-automated and one manual, the schemes for which the processes are completed are functionally equivalent. It would only require routine skill in the art to automate a known process. *See In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194(CCPA 1598).*
>
> Given the teachings of Allen a person having ordinary skill in the art would have readily recognized the uses and advantages of automating the manual postal mail forwarding system of *including an indicator or marking in place of the incorrect address* indicating the mail as being forwarded and indicating that the old address is no longer current for the recipient order to distinguish the forwarded mail or messages from the regularly received mail or messages. (*emphasis added*).

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Office Action dated 7/8/2004, Pages 4-5.

Applicants respectfully disagree. The present invention does not claim a mechanism of including an indicator or marking in place of the incorrect address. By replacing the incorrect address with the forward to address to facilitate forwarding of the mail to the correct address, the recipient is provided no indication that the mail was originally directed to the incorrect address in the system described by Allen. For example, Allen states the following:

> The *forwarding address* and delivery point ZIP marking number are printed on the mailpiece *in place* of the incorrect address and the mailpiece is returned to the mail stream for delivery to the addressee.

Allen, Abstract. (*emphasis added*).

By placing the forwarding address *in place* of the incorrect address, the recipient has no indication of the original address absent the inclusion of an indicator of the original address (the incorrect address). Thus, Allen fails to describe or suggest any of the deficiencies of McDowell, and McDowell is insufficient, alone or in combination with Allen, to obviate claims 10, 21 and 23.

Additionally, the Office Action has rejected claims 3, 5-9, 14, and 16-20 under 35 U.S.C. § 103(a) over McDowell in view of Allen and further in view of U.S. Patent No. 6,088,720 to Berkowitz (hereinafter Berkowitz).

Berkowitz generally describes a system for manipulation of electronic messages that have an expired expiration date in an electronic mailbox. Berkowitz is wholly silent with regard to "including an indicator" that identifies an electronic mail message as being forwarded from an "old address of a recipient" that is to be forwarded to "another address associated with the recipient," and thus additionally fails to describe or suggest sending an electronic mail message with the indicator that identifies the electronic mail message as such. Applicant's note no purported contribution of Allen is recited in the rejection of claims 3, 5-9, 14, and 16-20 although the rejection sets forth Allen as contributing to the teachings of the rejected claims. Nevertheless, the deficiencies of Allen having been noted above, and neither Berkowitz or Allen provide for the deficiencies of McDowell.

Additionally, each of claims 3, 5-7-9, 14, and 16-20 are dependent on one of base claims 1 and 12 that have already been demonstrated to be allowable. The same distinctions apply between these claims and the base claims from which they are

dependent, and thus claims 3, 5-9, 14, and 16-20 are non-obvious at least by virtue of their dependence on allowable base claim.

Therefore, the rejection of claims 3, 5-9, 14, and 16-20 under 35 U.S.C. § 103(a) over McDowell in view of Allen and further in view of Berkowitz have been overcome, and such a notice is respectfully requested.
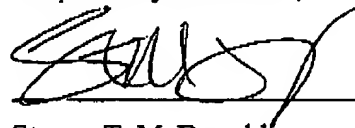
II. Conclusion

It is respectfully urged that the subject application is patentable over McDowell, Henderson, Allen and Berkowitz and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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